

REMARKS

The Office Action, on page 2, requires restriction to one of the following groups under 35 U.S.C. §121:

- Group I: Claims 44-74 drawn to a method of selecting inhibitors of an autoinducer classified in class 514 subclass -438 and 461;
- Group II: Claims 44-73 and 75 drawn to a method of selecting inhibitors of an autoinducer classified in class 514 subclass -438 and 461;
- Group III: Claims 44-73 and 76 drawn to a method of selecting inhibitors of an autoinducer classified in class 514 subclass -438 and 461;
- Group IV: Claims 77-79 drawn to an inhibitor classified in class 540, subclass ____??.

Applicants are required to elect one of the above groups for prosecution on the merits. Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper.

First, Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a *single* invention, which merit examination of all of these claims in a single application. More particularly, all of the claims are linked by a single, searchable, unifying aspect; *i.e.*, autoinducer molecules of *Pseudomonas aeruginosa*. More specifically, the single, searchable unifying aspect is a method of identifying an inhibitor of an autoinducer.

Groups I, II, III are all subgeneric positions relative to the method of claim 44, which method includes the step of "measuring the ability of the treated autoinducer molecule to stimulate the activity of a *selected gene*," and thus a search of claim 44 would, at a minimum, encompass the claims of Groups I, II, and III. Moreover, claim 75 of Group II is dependent upon claim 74 of Group I, and claim 76 of Group III is dependent upon claim 75 of Group II. Therefore, claim 75 includes all of the limitations of claim 74, and claim 76 includes all of the

limitations of claim 75, controverting the statement in the Office Action on page 2 that Groups I, II, and III are different methods using different steps. In fact, both claims 75 and 76 are separate embodiments of the generic claim 44 of Group I that relate to the use of a reporter gene to determine the effect of the autoinducer molecule on *E. coli* MG4.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (7th ed., Rel. 78A, March 1999).

That is, even, assuming *arguendo* that the above-enumerated groups of claims are drawn to distinct inventions, the Examiner **must** still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true inasmuch as Groups I-III have ***exactly the same classification***; i.e., class -438, subclass 461. Therefore, the statement in the Office Action at page 3, second full paragraph, to the effect that the "groups have acquired a separate status in the art" is not accurate. Indeed, if the groups had acquired a separate status in the art, the Patent Office would not have classified them in the same class. Given this identity of classification and the powerful computer-based search engines and data bases at the Examiner's disposal, Applicants submit that no serious burden will result from searching and examining all claims of Groups I-IV in the same application.

Therefore, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be searched and examined in a single application. At a minimum, Applicants request that Groups I-III be rejoined into a single group.


Nevertheless, in compliance with the directives in the Office Action and in order to expedite prosecution of the instant application, Applicants hereby elect, subject to the foregoing traverse, Group I, claims 44-74 drawn to a method of selecting inhibitors of an autoinducer classified in class 514 subclass -438 and 461.

If the Examiner is not persuaded by the foregoing arguments traversing the restriction requirement, Applicants respectfully request the Examiner to call the undersigned to set up a telephonic interview with the Examiner and the Examiner's supervisor to discuss the matter.

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